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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/594,501	09/28/2006	Hiroaki Hibino	023174-0175	3792
22428 7590 09/21/2007 FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			EXAMINER NAGUBANDI, LALITHA	
			ART UNIT 1621	PAPER NUMBER
			MAIL DATE 09/21/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/594,501	Applicant(s) HIBINO ET AL.	
	Examiner Lalitha Nagubandi	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7/31/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

Detailed Office Action

Status of the Claims

Claims 1- 7 are pending in this application. Claims 1- 7 are considered for examination in this office action.

Priority

This application is a 371 of PCT/JP05/06578 dated 03/29/2005, which claims benefit foreign application Japan 2004-108760 dated 04/01/2004.

Specification

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicants' cooperation is requested in correcting any errors of which applicant may become aware of in the specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

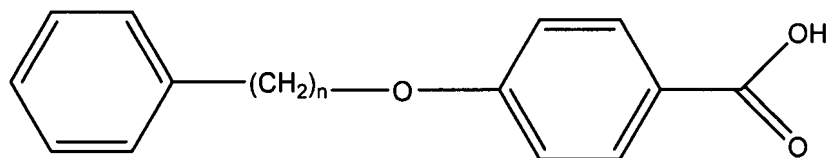
1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102 (e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1 - 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al (US Pat. No. 5,587,483 dt. 12/24/1996).

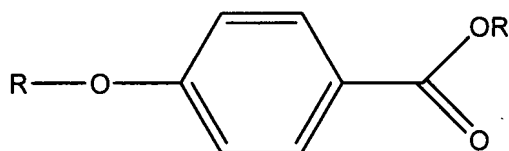
Applicants claim a method for producing a compound of the following formula:

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(I)

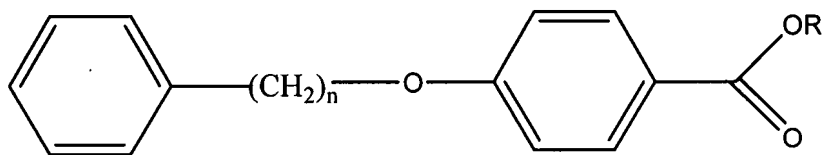
where n is an integer of 1 to 6. The instant method is characterized by hydrolyzing a solution containing the corresponding ester and a compound represented by the following formula:



(II)

Wherein R is as defined in the claim.

The claims embody a method for the preparation of the ester of the following formula, starting from aryl alkyl halide.



(III)

Further, the instant process embodies, use of an aprotic polar solvent.

Determination of the scope and content of prior art

Johnson et al teach a process for producing 4-(4-phenyl butoxy) benzoic acid from methyl 4-(4-phenylbutoxy) benzoate. The prior art also teaches the process of making the esters starting from 4-phenyl butyl bromide and 4-hydroxy benzoate. Further, the process teaches the hydrolysis of ester by adjusting the pH to 2-3. The examiner contends that the compound of formula II was an inherent byproduct in the reaction of Johnson.

Ascertainment of the difference between the prior art and claims

The difference between the prior art disclosed and the instant claims is that Johnson teaches the process (see col. 6 lines 25-50) in detail, all the steps involved in preparing aryl alkoxy benzoic acid as embodied in the instant process. However, the process differs from the instant process in the **pH**.

Finding of prima facie obviousness-rationale and motivation

It would have been obvious to one having ordinary skill in the art to have adjusted the pH to 4 which is still in the acidic range, in the process of Johnson's and an ordinary artisan would have expected a reasonable expectation of success in obtaining the instant products.

The examiner contends that it is a routine practice of optimization during the process development like in the instant case, where a pH is adjusted within a range. In the instant case **pH 4** still falls close to prior art range of **pH 3**, unless the claimed pH is crucial to the claimed invention it is obvious to one skilled in the art to be motivated to modify such a parameter and an ordinary artisan would be expected to achieve reasonable expectation of success.

Conclusion

No claims are allowed

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalitha Nagubandi whose telephone number is 571 272 7996.

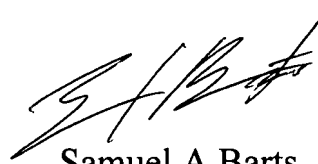
The examiner can normally be reached on 6.30am to 3.30pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne, Eyler can be reached on 571 272 0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Lalitha Nagubandi
Patent Examiner
Technology Center 1600

September 17th, 2007.



Samuel A Barts

Primary Patent Examiner
Technology Center 1600